

Appln. No. 10/760,035  
Filing Date: January 16, 2004  
Reply to Office action mailed January 22, 2008  
Amendment dated June 23, 2008

## **REMARKS**

Claims 22-38 and 54-59 are pending in the Application and all were rejected in the Office action mailed January 22, 2008. Claims 22-24, 30, 33, 54, and 59 are amended, and new claims 78-121 are added by this response. Claims 22, 30, 54, 78, 96, and 109 are independent claims. Claims 23-29 and 87-89, claims 31-38 and 90-92, claims 55-59 and 93-95, claims 79-86, claims 97-108, and claims 110-121 depend, respectively, from independent claims 22, 30, 54, 78, 96, and 109.

Applicants respectfully request reconsideration of claims 22-38 and 54-59, and consideration of new claims 78-121, in view of the amendments set forth above, in light of the arguments that follow.

### **Amendments to the Claims**

Claims 22, 30, and 54 have been amended as set forth above. Support for these amendments may be found, for example, at pages 66-72 and Figs. 1C, 2, and 21-25 of the Application. Applicants respectfully submit that these amendments do not add new matter.

Claim 23 was amended as shown above, solely in response to the request of the Office, in order to further prosecution of the Application. Applicants respectfully submit that these amendments do not add new matter.

Claims 24, 33, and 59 were amended solely in response to the request of the Office, and to maintain consistency of language, in order to further prosecution in the Application. Applicants respectfully submit that these amendments do not add new matter.

### **Claim Objections**

Claim 23 was objected due to informalities. Applicants respectfully disagree with the objection. Notwithstanding, Applicants have amended claim 23 as suggested by the Office. Applicants respectfully submit that this amendment does not add new matter, and that the objection to claim 23 has been overcome.

## **Claim Rejections**

Claims 24, 33, and 59 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully traverse the rejection. Notwithstanding, Applicants have amended claims 24, 33, and 59 to address the rejection, believe that claims 24, 33, and 59 are in accordance with 35 U.S.C. §112, second paragraph, and respectfully request that the rejection of claims 24, 33, and 59 under 35 U.S.C. §112, second paragraph, be reconsidered and withdrawn.

Claims 22, 26-30, 36-38, 54, and 56-57 were rejected under 35 U.S.C. §102(e) as being anticipated by Heidari (US 5,550,893). Claims 25, 31, and 55 were rejected under 35 U.S.C. §103(a) as being unpatentable over Heidari. Claims 23, 24, 32, 33, 58, and 59 were rejected under 35 U.S.C. §103(a) as being unpatentable over Heidari in view of Penners et al. (US 5,793,762, hereinafter “Penners”). Applicants respectfully traverse the rejections. Notwithstanding, Applicants have amended independent claims 22, 30, and 54 as set forth above, rendering the rejections of the Office action moot.

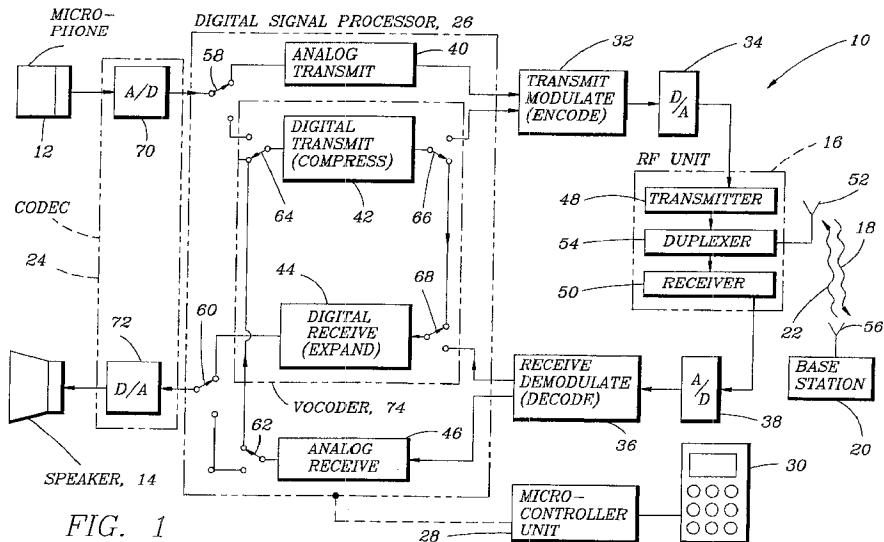
### **I. Heidari Does Not Anticipate Claims 22, 26-30, 36-38, 54, And 56-57**

With regard to the anticipation rejections, MPEP 2131 states, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). MPEP 2131 also states, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

With regard to claim 22, Applicants respectfully submit that Heidari fails to teach, suggest, or disclose each and every element of Applicants’ claim 22, which has been amended to recite, “[a] portable terminal device for supporting voice communication via a wireless packet network, the device comprising: a microphone for transducing sound into a first analog voice stream; at least one converter for converting the first analog voice stream to produce digital voice packets; a transmitter for transmitting, via the wireless packet network, the digital voice packets from the at least one converter; a

receiver for receiving digital voice packets from a base station in the wireless packet network; the at least one converter for converting received digital voice packets to a second analog voice stream; a transducer for transducing the second analog voice stream into sound; wherein the portable terminal device evaluates a message wirelessly received from the base station and sends to the base station an indication of a data rate based on the evaluation; and wherein the base station selects a data rate for transmitting digital voice packets to the portable terminal device, based upon the indication of a data rate.”

Applicants respectfully submit that Heidari fails to teach or suggest, at least, “...wherein the portable terminal device evaluates a message wirelessly received from the base station and sends to the base station an indication of a data rate based on the evaluation;...”, and “...wherein the base station selects a data rate for transmitting digital voice packets to the portable terminal device, based upon the indication of a data rate.” Applicants respectfully submit that the Office cites only Fig. 1 of Heidari as teaching the elements of Applicants’ claim 22. Fig. 1 of Heidari is reproduced below:



Applicants respectfully submit that Fig. 1 of Heidari simply shows a block diagram showing the audio portion of a mobile telephone incorporating the invention, a set of switches of a digital signal processor of the telephone being shown in positions for routing a voice signal in the analog communication mode including a routing of a received voice signal through a vocoder to impart a digitally processed quality to the voice signal outputted by a speaker of the telephone. There is nothing in the illustration of Fig. 1 of Heidari, however, that teaches or suggests where a portable terminal device evaluates a message wirelessly received from a base station, or where a portable terminal sends an indication of a data rate based on such an evaluation to a base station. The cited portion of Heidari also does not teach or suggest where the base station selects a data rate for transmitting digital voice packets to the portable terminal device, based upon the indication of a data rate, in accordance with Applicants' amended claim 22.

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Applicants have reviewed the disclosure of Heidari, and have been unable to identify where Heidari anticipates each and every element of Applicants' amended claim 22. If Applicants have overlooked such teachings, Applicants respectfully request that the Office specifically identify the corresponding teachings of Heidari and provide a detailed explanation and interpretation of how and why the cited portions of the reference disclose the elements and structure recited by Applicants' amended claim 22.

Based at least upon the above, Applicants respectfully submit that Heidari fails to teach or suggest each and every element of Applicants' amended claim 22, as required by M.P.E.P. §2131, and that Heidari does not anticipate Applicants' amended claim 22. Applicants therefore believe that amended claim 22 is allowable over Heidari, for at least the reasons set forth above. Applicants respectfully submit that claims 23-29 and 87-89 depend either directly or indirectly from allowable claim 22, and that Heidari fails to anticipate claims 23-29 and 87-89, as well. Accordingly, Applicants respectfully request that the rejection of claims 22 and 26-29 under 35 U.S.C. §102(e) be reconsidered and withdrawn.

With regard to amended claims 30 and 54, Applicants respectfully submit that claims 30 and 54 have been amended to recite limitations similar to those of claim 22, and that the Office rejects claims 30 and 54 for the same reasons used in the rejection of claim 22. Therefore, Applicants' respectfully submit that amended claims 30 and 54 are also allowable over Heidari for at least the reasons set forth above with regard to the rejection of claim 22. Applicants respectfully submit that claims 31-38 and 90-92, and claims 55-59 and 93-95 depend, respectively, from claims 30 and 54, and are also not anticipated by Heidari, for at least the same reasons. Accordingly, Applicants respectfully request that the rejections of claims 30, 36-38, 54, 56, and 57 under 35 U.S.C. 102(e) be reconsidered and withdrawn.

## **II. Heidari In View Of Official Notice Does Not Render Claims 25, 31, and 55 Unpatentable**

Applicants respectfully note that the Office rejected claims 25, 31, and 55 under 35 U.S.C. §103(a) in view of Heidari, taking Official Notice. Applicants respectfully

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submit that claims 25, 31, and 55 depend, respectively, from claims 22, 30, and 54. Applicants believe that claims 22, 30, and 54 are allowable over Heidari, in that the grounds set forth by the Office for the rejection of claims 25, 31, and 55 do not overcome the shortcomings of Heidari, for at least the reasons set forth above. Because claims 22, 30, and 54 are allowable over the proposed grounds of rejection, Applicants respectfully submit that claims 25, 31, and 55 are also allowable, for at least the same reasons. Accordingly, Applicants respectfully request that the rejection of claims 25, 31, and 55 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

### **III. The Proposed Combination Of Heidari And Penners Does Not Render Claims 23, 24, 32, 33, 58, And 59 Unpatentable**

Applicants respectfully submit that claims 23 and 24, claims 32 and 33, and claims 58 and 59 depend, respectively, from claims 22, 30, and 54. Applicants believe that claims 22, 30, and 54 are allowable over the proposed combination of references, in that Penners fails to overcome the deficiencies of Heidari, set forth above. Because claims 22, 30, and 54 are allowable over Heidari and Penners, Applicants respectfully submit that claims 23, 24, 32, 33, 58, and 59 are also allowable, for at least the same reasons. Accordingly, Applicants respectfully request that the rejections of claims 23, 24, 32, 33, 58, and 59 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

### **Newly Added Claims**

Applicants have added new claims 78-121. Claims 78, 96, and 109 are independent claims that recite limitations similar in many ways to the limitations of claims 22, 30, and 54, while dependent claims 79-83, which depend from claim 78, recite limitations similar to existing claims 55-59. New dependent claims 84-86, 87-89, 90-92, 93-95, 97-108, and 110-121 depend, respectively, from independent claims 78, 22, 30, 54, 96, and 109.

Support for new claims 78-121 may be found, for example, at pages 66-72 and Figs. 1C, 2, and 21-25 of the Application. Applicants respectfully submit that no new matter is added by these new claims.

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Applicants have previously paid fees for 6 independent claims and 56 total claims and the Application presently has 6 independent and 67 total claims. Therefore additional claim fees are believed to be due in the amount of  $11 \times \$50 = \$550$ .

### **Conclusion**

The Applicants believe that all of pending claims 22-38, 54-59, and 78-121 are in condition for allowance. Therefore, an early Office Action on the merits and allowance of claims 22-38, 54-59, and 78-121 is respectfully requested.

The Commissioner is hereby authorized to charge any fees required by this submission to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Should the Examiner disagree or have any questions regarding this submission, the Applicants invite the Examiner to telephone the undersigned at (312) 775-8000 to resolve any issues.

Respectfully submitted,

Dated: June 23, 2008 By /Kevin E. Borg/  
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